

REMARKS

Claims 1 through 20 are currently pending in the application.

This amendment is in response to the Office Action of December 22, 2003.

35 U.S.C. § 101 Double Patenting Rejection

Claims 1 through 20 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 10 of prior U.S. Patent 6,306,687 (hereinafter referred to as the '687 patent).

Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants submit that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting does not exist. *In re Vogel*, 433 F.2d 438, 164 USPQ 619 (CCPA 1970)

Applicants submit that the embodiments of the presently claimed inventions as set forth in presently amended independent claims 1 and 10 of the present application are different inventions than the embodiments of the inventions as set forth in independent claims 1 and 10 of the '687 patent. For instance, the embodiment of the presently claimed invention as set forth in presently amended independent claim 1 of the present application has an element of the claimed inventions calling for "adhesively attaching the segment of tape to portions of the lead frame, the segment of tape extending across the opening having adhesive located thereon forming attachment locations for the semiconductor device and for portions of the lead fingers of a lead frame" "attaching portions lead fingers of the plurality of lead fingers to a portion of the segment of tape", and "attaching the semiconductor device to at least a portion of the segment of tape at the attachment location for the semiconductor device using the thermosetting adhesive located on a portion of the segment of tape, the semiconductor device having a portion thereof located within the opening formed by the plurality of lead fingers of the lead" whereas the embodiment of the claimed invention of independent claim 1 of the '687 patent does not. More specifically, the embodiment of the claimed invention of independent claim 1 of the '687 patent does not

included any element of the invention whatsoever regarding “attaching portions lead fingers of the plurality of lead fingers to a portion of the segment of tape” as does the embodiment of the presently claimed invention of corresponding claim 1 of the present application. Applicants further assert that such an element of the embodiment of the presently claimed invention is neither expressly claimed nor inherently claimed in corresponding independent claim 1 of the '687 patent. There is no reference whatsoever to such an element in the embodiment of the invention set forth in claim 1 of the '687 patent. Therefore, there is no way that identical embodiments of the inventions are being claimed between the embodiment of the invention of presently amended independent claim 1 of the present application and the embodiment of the invention of corresponding independent claim 1 of the '687 patent. Accordingly, no statutory double patenting under 35 U.S.C. § 101 is present between presently amended independent claim 1 of the present application and corresponding independent claim 1 of the '687 patent because identical subject matter is not being claimed.

Similarly, the embodiment of the presently claimed invention as set forth in presently amended independent claim 10 of the present application has an element of the claimed inventions calling for “attaching at least two tape segments to portions of the lead frame, the at least two tape segments being spaced to define at least one opening between the at least two tape segments providing an attachment location for the semiconductor device therein and portions of the plurality of lead fingers of the lead frame thereto, said at least two tape segments shaped for extending across the opening forming the attachment surface of the semiconductor device” whereas the embodiment of the claimed invention of independent claim 10 of the '687 patent does not. The embodiment of the claimed invention set forth in corresponding claim 10 of the '687 patent does not have any element of the claimed invention, either expressly set forth or inherently set forth, calling for the “ . . . at least two tape segments providing an attachment location for . . . portions of the plurality of lead fingers of the lead frame thereto. Therefore, there is no way that identical embodiments of the inventions are being claimed between the embodiment of the invention of presently amended independent claim 10 of the present application and the embodiment of the invention of corresponding independent claim 10 of the '687 patent because corresponding independent claim 10 of the '687 patent does not

require the attachment of portions of the lead fingers to portions of the at least two segments of tape. Accordingly, no statutory double patenting under 35 U.S.C. § 101 is present between presently amended independent claim 10 of the present application and corresponding independent claim 10 of the '687 patent because identical subject matter is not being claimed.

Applicants assert that the test for claiming the same invention under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim but not the other? Clearly in the present application regarding the presently claimed inventions of presently amended independent claims 1 and 10 to infringe either of such claims other elements of the invention must be present than corresponding claims 1 and 10 of the '687 patent. Accordingly, since different embodiments of the invention are being claimed, no statutory double patenting under 35 U.S.C. § 101 can exist because identical subject matter is not being claimed in the present application and the '687 patent.

Yet further, since presently amended independent claims 1 and 10 are allowable, dependent claims 2 through 9 and 11 through 20 are allowable.

In summary, Applicants submit that claims 1 through 20 are clearly allowable because identical subject matter is not being claimed as set forth herein regarding the embodiments of the inventions set forth in presently amended independent claims 1 and 10 of the present application and independent claims 1 and 10 of the '687 patent.

Applicants request the allowance of claims 1 through 20 and the case passed for issue.

Respectfully submitted,



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for extending across the opening forming the attachment surface of the semiconductor device.

11. (Previously Presented) The method of claim 10, further including forming a plurality of apertures in at least one tape segment of the at least two tape segments.

12. (Original) The method of claim 11, wherein the plurality of apertures substantially forms a grid-like pattern of apertures.

13. (Previously Presented) The method of claim 11, further including:
attaching the semiconductor device to the at least one tape segment of the at least two tape segments having at least a portion of an outer periphery of the semiconductor device adjacent to a periphery of at least one aperture of the plurality of apertures.

14. (Previously Presented) The method of claim 13, wherein the semiconductor device is attached to the at least one tape segment such that at least a portion of the outer periphery of the semiconductor device is positioned within the at least one aperture of the plurality of apertures.

15. (Original) The method of claim 13, further including:
wire bonding contacts of the semiconductor device to the ends of the plurality of lead fingers.

16. (Original) The method of claim 10, further including:
packaging the semiconductor device in an encapsulating material to form a packaged semiconductor integrated circuit device.

17. (Previously Presented) The method of claim 16, further comprising forming the at least two tape segments to fit within the encapsulating material.